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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PR

Office Action Summary

Application No.

09/982,365

Applicant(s)

LANE, BRADLEY P.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 2-15, 17 and 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 16 and 18-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Election/Restriction

In regards to Claims 34-36, a restriction correction has been made wherein claims 34-36 are directed to the non-elected invention as stated in Group II of Paper No. 3, whereby a computer database is used to generate a listing. The elected invention of Group I now consist of Claims 1, 16 and 18-33. The examiner does apologize for this mistake.

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Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a fastener formed of hook and loop material must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not disclose a fastener positioned on the upper and lower surfaces of the hinge section of a page, wherein the fastener is formed of hook and loop material as stated in Claims 24 and 25.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 16, 18-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 recites the limitation "the location" in line 12. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 16 recites the limitations: "the corresponding position indicator" in line 14; and "the graphic" in line 15. There is insufficient antecedent basis for these limitations in the claim.

5. Claim 18 recites the limitations: "the respective compact disc locations" in line 19; and "a well section" in line 14. Should this be "a gutter section"? There is insufficient antecedent basis for this limitation in the claim.

6. Claims 19-33 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 19-33 disclose a "disc management system" in the preamble which is not consistent with independent claim 18, which discloses a "display apparatus" in the preamble. Applicant must note that a display apparatus (which does not have to include a "disc") is not equivalent to a "disc management system (which does have to include a "disc").

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (6,325,207) in view of Staar (5,136,562) and further in view of Vineyard et al (6,265,043).

Drew discloses in Fig. 3A-4, an organizer comprising a looseleaf page for a display album having storage sleeves forming pockets (10 in Fig. 4) with an opening (A) along one side (20), a viewing window (B) for viewing associated liner (18); wherein the pocket has indicia (written in 36); and wherein a compact disc is placed in the pocket.

However, Drew does not disclose: a plurality of compact discs to be organized in the slots of a compact disc changer; and wherein the discs have a title.

Staar discloses in Fig. 1-3, a plurality of compact discs organized in the slots (24) of a compact disc changer, wherein the slots have a slot identifier (20 in Fig. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Drew's organizer to include compact discs which can be stored

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and identified in a disc changer as taught by Staar for the purpose of providing compact discs which can be placed in a CD changer.

However, Drew and Staar do not disclose compact discs with titles.

Vineyard et al et al discloses in Fig. 1, a compact disc (A) with printed indicia (28 and 30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Drew's and Staar's compact disc organizer to include a compact disc comprising printed indicia as taught by Vineyard et al et al for the purpose of labeling the compact disc.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia on the CD, pocket, and slot, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to pocket indicia matching the respective slot identifier so that a user may determine the location of compact discs, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235

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(CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The pocket indicia of Drew is capable of disclosing indicia matching slot identifiers.

In regards to claim 1, the method of organizing is inherently taught by Drew, Staar and Vineyard et al.

8. Claim 16, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (5,908,259) in view of Bakke et al (6,135,662).

Johnson discloses Fig. 1 and 3, an organizer comprising a binder (12) having a plurality of sheets; a pre-established list of titles (22A); index identifiers (22B); and position identifiers (16).

However, Johnson does not disclose: sheets with transparent viewing pockets; wherein the position identifiers are placed adjacent to the pockets; wherein visual displays are placed in the pockets.

Bakke et al discloses in Fig. 1 and 7, of an organizer comprising: sheets (26 and 28) with transparent viewing pockets (48 and 50); wherein the position identifiers (78, 80, 82) are placed adjacent to the pockets; wherein visual displays (articles) are placed in the pockets.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson's organizer to include a transparent pocketed sheet having position identifiers as taught by Bakke et al for the purpose of effectively organizing the contents placed in the pockets.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to include any type of indicia on the list such as a list of recordings, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to the pre-established list being list of recordings, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The list of Johnson is capable of listing recording titles.

In regards to claim 16, the method of organizing is inherently taught by Johnson and Bakke et al.

9. Claims 18, 19, 23-30 and 33, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson (3,645,637) in view of Bergh et al (5,620,271) and further in view of Drew.

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Gustafson discloses in Fig. 1, 15 and 16, a display apparatus comprising: an elongated spine member (24) having an upper flange and lower flange (portion of (81 and 83)) folded to form an upper and lower retention recess (space between flange and sheets (23) as shown in Fig 16); a first cover member (21) and a second cover member having a flexible hook (62) for insertion into the upper and lower recesses, wherein the hooks cooperate with the flanges to pivotally attach the cover members; a plurality of detachable posts (44) for securing the first and second covers and further for passing through a perforated hinge section of the attached loose leaf pages, wherein the post ends are covered by a folded flange flap (as seen in Fig. 13).

However, Gustafson does not disclose looseleaf pages comprising: a well section positioned between the perforated hinge section and the display section, wherein the display section has at least one pocket with a non-woven backing, a common divider, an opposing transparent window, and indicia.

Bergh et al discloses in Fig. 1B and 2, a looseleaf pages comprising a well section (15) positioned between the hinge section (16) and the display section (20-23), wherein the display section has a 2x2 arrangement pocket with a non-woven backing (56), a common divider (Fig. 5, which consist of backing (56)), and an opposing transparent window.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gustafson's display apparatus to include looseleaf pages having a well section, a display section having a pocket, and a hinge section as taught by Bergh et al for holding discs in a binder.

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However, Gustafson as modified by Bergh et al does not disclose: a pocket having indicia and a thumb notch.

Drew disclose in Fig. 4, a pocket having a section (36) for writing indicia and a thumb notch (38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gustafson's and Bergh et al's display apparatus to include a pocket having indicia as taught by Drew for the purpose of labeling the pockets contents.

In regards to **Claims 19**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many pockets on the page as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claim 22**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the opening of the pocket at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 26**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to divide the post into detachable sections, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

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In regards to **Claims 29, 30 and 33**, it would have been an obvious matter of design choice to construct the pockets and well section in any desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

10. Claims 20, 21, 31 and 32 as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson (3,645,637) in view of Bergh et al (5,620,271) and Drew, and further in view of Ozeki (5,290,118).

Gustafson as modified by Bergh et al and Drew discloses a display apparatus comprising all the elements as claimed in Claim 18. However, Gustafson does not disclose a display apparatus comprising: twenty-six pages including one page with a table of contents insert; a 1x1 pocket arrangement; a 2x1 pocket arrangement; and pages being 7 and 7/8 inches wide and 6 inches tall.

Ozeki discloses in Fig. 4 and 5, a display apparatus comprising pages (21 and 22) wherein one page (21) includes a table of contents listing (6, as stated Col. 3, lines 53-57) the titles of the compact discs.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gustafson's display apparatus to include a page having a table of contents listing as taught by Ozeki for the purpose of revealing the contents in the organizer.

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In regards to **Claims 20, 21, 31 and 32**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many pages as desired in the apparatus, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 20 and 21**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the pockets in any desirable arrangement, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, it would have been an obvious matter of design choice to construct the pages in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In regards to **Claim 32** wherein the table of contents links each of the titles to a position in the CD changer, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The table of contents listing of Ozeki is capable of linking each title to a position in the CD changer.

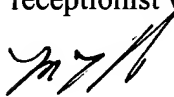
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Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Brandt, Udwin et al, Dottel, Bergh et al ('683), Eskandry, Nelson et al, Ho, Richards, Lo, Palmer, Bradley et al, Nelson et al, Miller, Shafer, and Ozeki ('528) disclose a method and apparatus for organizing. Colonna discloses a binding apparatus.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 20, 2003



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